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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zuffa, LLC

Serial No. 75982336

Parker H. Bagley of Milbank, Tweed, Hadley & McCloy LLP for Zuffa, LLC.

Debra Lee, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).[1]

Before Hairston, Chapman and Drost, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On January 7, 2002, Zuffa, LLC (a Nevada limited liability company, located in Las Vegas, Nevada) filed an application to register the mark ULTIMATE FIGHTING on the Principal Register for goods and services in International Classes 9, 25, 28 and 41. The Class 25 goods (and certain goods and services in Classes 9, 28 and 41) were divided

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[1] The application was assigned to this Examining Attorney at the time the Examining Attorney's brief was due.

out pursuant to applicant's Request to Divide filed March 8, 2002, resulting in related application Serial No. 76356163. Applicant deleted its Class 28 goods through an amendment filed September 3, 2003 (via certificate of mailing). The Class 9 goods remaining in this application were divided out pursuant to applicant's Request to Divide filed December 14, 2004, resulting in related application Serial No. 75983542. Thus, the application before us currently involves only the services in International Class 41 identified as "entertainment, namely live stage shows and performances featuring sports and mixed martial arts."[2]

The application was originally based on applicant's assertion of a bona fide intention to use the mark in commerce on or in connection with the identified goods and services. Applicant filed an Amendment to Allege Use, with a specimen and claiming a date of first use and first use in commerce of November 1993 for the services in International Class 41, which was accepted by the USPTO.

[2] Applicant claims ownership of Registration Nos. 1939277 for the mark THE ULTIMATE FIGHTING CHAMPIONSHIP ("fighting championship" disclaimed) for entertainment services, namely conducting martial arts competitions, events and personal appearances for live and prerecorded transmission; and Registration No. 2170463 for the mark THE ULTIMATE FIGHTING CHAMPIONSHIP and design for prerecorded video optical disks featuring sports and entertainment events and prerecorded audio and videotapes featuring sports and entertainment events.

The Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that ULTIMATE FIGHTING, when used in connection with the services of applicant, is generic of them; and that applicant's claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), is not sufficient in view of the nature of the proposed mark.

When the refusals were made final, applicant appealed to the Board. Both applicant and the Examining Attorney have filed briefs; applicant did not request an oral hearing.

The Examining Attorney contends that the proposed mark is generic for applicant's identified services of live stage shows and performances featuring sports and mixed marital arts, and it is thus incapable of functioning as a mark and it cannot acquire distinctiveness; and that even if the proposed mark is held not to be generic, the word "fighting" is generic for fighting competitions,[3] making the mark highly descriptive, and increasing applicant's burden

[3] The Examining Attorney requested in her brief (footnote 7) that the Board take judicial notice of definitions of "fighting" she submitted from Dictitonary.com. The request is granted to the extent that we take judicial notice of the reference therein to The American Heritage Dictionary (Fourth Edition 2000) definition as "n. …3.a A physical conflict between two or more individuals. 3b. Sports. A boxing or wrestling match."

of proof to establish acquired distinctiveness, which applicant has not met. That is, the Examining Attorney has refused registration as the phrase ULTIMATE FIGHTING describes a type of athletic competition by its common commercial name; and that applicant's evidence of acquired distinctiveness is insufficient.

The Examining Attorney refers to applicant's website use of ULTIMATE FIGHTING to refer to the name of the sport as follows: "The Ultimate Fighting Championship, the world's leading ultimate fighting sports event, will make its debut on basic cable television… ."

The Examining Attorney submitted (i) printouts of several excerpted stories retrieved from the Nexis database, and (ii) printouts of pages from a few third-party websites, all to show that "ULTIMATE FIGHTING" describes a type of mixed martial arts. Examples of the excerpted stories retrieved from the Nexis database are set forth below:

> Headline: Severn Gym Owners Promote 'All-out' Fighting Methods
> …Take a little bit of kickboxing, add some wrestling and throw in some martial arts and adrenalin, and you've got ultimate fighting. …
> As Maryland law now stands, mixed martial arts matches and tournaments aren't expressly allowed, said Patrick Panola, executive director of the commission. …

Koblinsky and Smith know they have an uphill battle, especially when it comes to dispelling the notion that ultimate fighting is a dangerous sport.
Smith is quick to point out that no one ever has been killed in an ultimate fighting match. … "The Maryland Gazette," January 17, 2004;

Headline: Kickboxing's 'Wrath' Unleashed
…Eric Bentz, a black belt instructor at Apollo's Karate, will make his pro debut under ultimate fighting rules against Daryan Wilkerson of Houston. … "Tulsa World (Oklahoma)," September 12, 2003;

Headline: Five Earn 1st, 2nd Places in National Jiu-Jitsu
…Memphis Karate Institute is sponsoring Fight Night 2 on Sept. 21 at Denim & Diamonds, 5353 Mendenhall Mall.
Fighters in mixed martial arts and from Ultimate Fighting-style championship and the Memphis Gracie Jui-Jitsu Training Association will participate. "The Commercial Appeal (Memphis, TN)," August 30, 2001; and

Headline: Kickboxer Smith in K-1 World Semis
…K-1 incorporates all disciplines of martial arts in an ultimate fighting sport.
Smith, a West Seattle High School graduate who operates his own kickboxing school in Bellvue, qualified for the semifinals by winning the North American K-1 Championship on May 5, also in Las Vegas.
Smith's title credentials include WKA, ISKA and WKC world kickboxing titles, Battlecades Extreme Fighting heavyweight champion, UFC Ultimate Fighting world champion, and World Martial Arts Council champion. … "The

Seattle Post-Intelligencer," June 28, 2001.

Applicant argues that the mark ULTIMATE FIGHTING is not the generic term for applicant's identified services; that the Examining Attorney has not established either that ULTIMATE FIGHTING names the genus or class of services at issue here or that the relevant public understands the term to refer to that class of services; that the generic names for applicant's services include "mixed martial arts fighting," "no holds barred fighting" and "cage fighting" but that ULTIMATE FIGHTING is applicant's mark identifying its goods and services; that the relevant public for the purchase of applicant's services consists of sports fans; that the evidence of record does not meet the Examining Attorney's burden necessary to establish genericness, particularly as the Examining Attorney's Nexis and Internet evidence shows a mixture of usages, including recognition of ULTIMATE FIGHTING as applicant's mark; that some misuses by media writers, and even a failure of applicant to capitalize the words "Ultimate Fighting" in a place on its website are sporadic and do not destroy applicant's use of the phrase as a mark recognized by the public; that doubt on the issue of genericness is resolved in favor of

applicant; and that applicant has established acquired distinctiveness in its mark ULTIMATE FIGHTING.

The Examining Attorney bears the burden of proving that the proposed mark is generic, and genericness must be demonstrated through "clear evidence." See In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd, unpubl'd, but appearing at 10 USPQ2d 1879 (Fed. Cir. 1989). The evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and In re Leatherman Tool Group, Inc., 32 USPQ2d 1443 (TTAB 1994), citing In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985).

The test for determining whether a designation is generic, as used in connection with the services in an application, turns upon how the term or phrase is perceived by the relevant public. See Loglan Institute Inc. v. Logical Language Group, Inc., 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two-step analysis: (1) what is the

genus of the goods or services in question? and (2) is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See In re The American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). As noted earlier, "the correct legal test for genericness, as set forth in *Marvin Ginn*, supra, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" American Fertility Society, supra.

In this case, the Examining Attorney has submitted some evidence of generic use of the words "ultimate fighting" to refer to a sporting competition. However, it is clear from the record that the overwhelming majority of the examples are direct references to applicant and, as applicant has explained, numerous other uses are indirect references to applicant inasmuch as they refer to events or personalities associated with applicant's services. There are relatively few references that simply show generic use of the phrase to refer to sporting events. Applicant contends that these are simply sporadic misuses of

applicant's mark ULTIMATE FIGHTING by the media, and that applicant cannot realistically take action against all journalists and their uses/misuses of applicant's mark.

As explained previously, our primary reviewing Court, the Court of Appeals for the Federal Circuit, has held that the burden of establishing genericness of a term or a whole phrase rests with the Office and that the showing must be based on clear evidence. See In re Merrill Lynch, supra, 4 USPQ2d at 1143; and In re The American Fertility Society, supra, 51 USPQ2d at 1835. Because the record before us shows varied uses of the phrase "ULTIMATE FIGHTING," we find that there is insufficient clear evidence that the phrase ULTIMATE FIGHTING is the generic or common descriptive term for the live stage shows and performances featuring sports and mixed martial arts to which applicant first applied the phrase. Although the Nexis and Internet evidence support a finding of mere descriptiveness, it simply does not establish that the phrase ULTIMATE FIGHTING is generic for the genus of applicant's involved services.

With regard to the second prong of the genericness test, the evidence of record as to how the relevant

purchasers[4] would perceive this term in relation to applicant's identified services involving entertainment services is mixed. There is significant evidence of ULTIMATE FIGHTING clearly referring to applicant and its entertainment services offered under the mark ULTIMATE FIGHTING. Further, many of the examples of generic use actually refer to applicant (either applicant's events or individuals/fighters associated with applicant) and are apparent misuses by journalists. Moreover, none of the evidence submitted by the Examining Attorney predates applicant's first use in November 1993. Thus, the Examining Attorney has not established that the relevant purchasing public would perceive the phrase ULTIMATE FIGHTING as the name of the genus of the services.

We find that the Examining Attorney has not established a prima facie showing that the phrase ULTIMATE FIGHTING is generic for applicant's identified entertainment services.

We turn to the question of whether applicant has met its burden to establish that the phrase ULTIMATE FIGHTING has acquired distinctiveness under Section 2(f) of the

[4] The Board finds that the relevant purchasers are fans who either attend or purchase pay-per-view for the live stage shows and performances of this mixed martial arts medium.

Trademark Act. Because applicant stated in its reply brief (p. 2) that it contends that its mark is inherently distinctive, we address the issue of mere descriptiveness of the phrase "ULTIMATE FIGHTING." There is sufficient evidence regarding use of the phrase "ULTIMATE FIGHTING" in connection with sporting events and competitions to establish that the phrase is merely descriptive thereof. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Thus, we will now determine whether applicant has submitted sufficient evidence of acquired distinctiveness under Section 2(f) to overcome the mere descriptiveness of the phrase.

Applicant has the burden of establishing that its mark has become distinctive. See Yamaha International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). The question of acquired distinctiveness is one of fact which must be determined on the evidence of record. As the Board stated in the case of Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996, 1999 (TTAB 1986):

> [e]valuation of the evidence requires a subjective judgment as to its sufficiency based on the nature of the mark and the conditions surrounding its use.

There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness, but generally, the more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. See In re Bongrain International (American) Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and Yamaha International Corp. v. Hoshino Gakki Co. Ltd., supra 6 USPQ2d at 1008. See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:17 and 15:66 and 15:70 (4th ed. 2005).

Having carefully reviewed the evidence of record, we find that applicant's evidence of acquired distinctiveness is sufficient to establish a prima facie showing thereof.[5] Applicant has submitted a declaration of over 5 years use of the mark ULTIMATE FIGHTING; the declaration of applicant's president, Dana White; 31 declarations by various people in the mixed martial arts field; printouts of applicant's website pages showing the list of applicant's fighters; a photocopy of the State of Nevada statute defining "mixed martial arts" (not using the words "ultimate fighting"); and evidence of applicant's policing

[5] In this case, the Examining Attorney contends that the phrase is highly descriptive thereby carrying a high threshold of proof from applicant. Even assuming that the phrase is highly descriptive of the identified services, we find that applicant's evidence of acquired distinctiveness is sufficient.

of its mark, ULTIMATE FIGHTING, including photocopies of (i) a court decision and (ii) a settlement agreement whereby applicant stopped two different entities from using the mark.

Specifically, the record shows that applicant (and its predecessor in interest) have used the mark ULTIMATE FIGHTING for applicant's entertainment services since November 1993; and that the use has been substantially exclusive and continuous for a period well exceeding the five years prior to the filing of applicant's application in January 2002. Applicant has spent over $10 million on advertising and promotion of the mark through national media including television, radio, magazines, newspapers and internet advertisements; that since September 2001, applicant has been the beneficiary of $50 million in commercial value from its partners and licensees pursuant to applicant's pay-per-view and broadcasting agreement with major national and regional cable and satellite pay-per-view providers (e.g., DISH Network, DirecTV); that applicant has generated over $50 million dollars in ticket sales, pay-per-view and broadcast licensing revenues for its ULTIMATE FIGHTING mixed martial arts events held in major sports arenas around the United States (e.g., New Jersey, Nevada, Florida); and that applicant's pay-per-view

live events have been purchased by several million pay-per-view subscribers and thereby were distributed to households, sports bars and similar pay-per-view distribution channels throughout the United States. Applicant's use of the mark for over 10 years, and its nationwide sales revenues and advertising expenditures are substantial.

Importantly, applicant has submitted 31 declarations of various people in the mixed martial arts field including Dr. Tony Alamo, Vice-chairman of the Nevada State Athletic Commission; Keith Kizer, Chief Deputy Attorney General, Gaming Division for the state of Nevada, and chief legal counsel for the Commission; Marcos Rosale Jr., a judge for the Nevada State Athletic Commission; A. L. Embanato, Jr., Vice-chairman of the Louisiana State Boxing & Wrestling Commission; managers and trainers of mixed martial arts fighters -- Peter Welch, boxer/trainer, and Donald House, trainer; owners of competing mixed martial arts events -- Reed Harris, VP World Extreme Cagefighting, and Dan Lambert, president Absolute Fighting Championship; and members of the media -- Ryan Bennett, NBC sports anchor, and Loretta Hart, journalist. In each of the 31 declarations, the declarant avers that within the industry ULTIMATE FIGHTING and ULTIMATE FIGHTING CHAMPIONSHIP are

each trademarks owned by applicant; that the marks are used to identify the specific mixed martial arts competitions promoted by applicant; and that due to applicant's long and extensive use of those trademarks, those in the industry as well as the fans of mixed martial arts associate the marks exclusively with applicant.

These declarations are significant direct evidence of purchaser and user recognition of the phrase ULTIMATE FIGHTING as applicant's mark for its entertainment services.

Here applicant has enjoyed considerable success in the sale of its entertainment services offered under the mark ULTIMATE FIGHTING. Applicant has consistently used the phrase as a service mark (with perhaps a misuse on its website at one time); and applicant has established that it polices its mark. There has been substantial exposure to the relevant public with significant nationwide sales and advertising figures.

We find that applicant's evidence is sufficient to establish acquired distinctiveness in ULTIMATE FIGHTING as its mark for the identified services. See In re Mine Safety Appliances Company, 66 USPQ2d 1694 (TTAB 2002).

Decision: The refusal to register on the Principal Register on the basis that applicant's mark is generic

under Section 2(e)(1) of the Trademark Act is reversed; and the refusal to register the mark under Section 2(f) of the Trademark Act is reversed. Accordingly, the application will proceed to publication with a notation of applicant's claim of acquired distinctiveness under Section 2(f).